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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/679,323

10/07/2003

Masahiro Inoue

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08/04/2006

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EXAMINER

WEST, LEWIS G

ART UNIT

PAPER NUMBER

2618

DATE MAILED: 08/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/679,323

Applicant(s)

INOUE, MASAHIRO

Examiner

Lewis G. West

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 July 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-8 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 10 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Arguments

Applicant's arguments filed July 5, 2006 have been fully considered but they are not persuasive.

In response to applicant's arguments, the recitation "Dedicated Short Range Communications" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). In the present claim, the focus of the body of the claim is actually the method of and material used for adhesion and could be applied to any vehicle attached radio in the same way, as being DSRC does would not change the structure of the components in the body of the claim. Therefore applicant's arguments sections "102b" and "103a Fischer/Baratono" are unpersuasive.

Regarding arguments section "103a Fisher/Baratono/Wunderlich", an extension of an antenna element is a change in shape, and is one of the more common ways known in the art to change an antenna's characteristics.

Claims 7 and 8 are argued based on dependency, and the parent arguments have been addressed. Further clearly only and outside portion (circumferential) portion of the protrusion may be in contact with the adhesive.

All arguments having been addressed and new claims having been added, this action is made FINAL and prosecution is now CLOSED.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 2 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Fisher (US 4,931,805).

Regarding claim 2, Fisher discloses a Dedicated Short-Range Communications (DSRC) on-board unit with an adhesive material comprising: an antenna (15) for communicating with roadside radio equipment (see col. 2 lines 10-13, cellular communications would involve communicating with a base station radio equipment, which could be roadside, and as the location of the equipment is merely an intended use and as no roadside equipment is positively claimed, the limitation is met by the art); a housing (outside engaging portion 13) in which only said antenna is housed (Col. 2 lines 35-47); and an adhesive material (in the context of this claim, both the silicon gel adhesive 34 and the double sided tape adhesive 32, or the combination of the two, read on this limitation) having a first surface affixed to said housing and a second surface for affixing to a vehicle window (Col. 2 lines 48-67), wherein: a protruding portion engaged with said adhesive material is disposed on said housing. (see Figure 4, wherein the silicon adhesive is engaged with a protruding portion of the device to be mounted by being applied to channel 30)

Regarding claim 8, Fisher discloses the Dedicated Short-Range Communications (DSRC) on-board unit with an adhesive material according to claim 1, wherein only a circumferential portion of the protruding portion is in engaged with the adhesive, (Figure 4).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fisher (US 4,931,805) in view of Baratono (US 6,549,793).

Regarding claim 1, Fisher discloses a Dedicated Short-Range Communications (DSRC) on-board unit with an adhesive material comprising: an antenna (15) and a radio portion a data processing portion (cellular phone) for communicating with roadside radio equipment (see col. 2 lines 10-13, cellular communications would involve communicating with a base station radio equipment, which could be roadside, and as the location of the equipment is merely an intended use and as no roadside equipment is positively claimed, the limitation is met by the art) a housing (outside engaging portion 13) in which at least antenna is housed (Col. 2 lines 35-47); and an adhesive material (in the context of this claim, both the silicon gel adhesive 34 and the double sided tape adhesive 32, or the combination of the two, read on this limitation) having a first surface affixed to said housing and a second surface for affixing to a vehicle window (Col. 2 lines 48-67), wherein: a protruding portion engaged with said adhesive material is disposed on said housing. (see Figure 4, wherein the silicon adhesive and tape are engaged with a protruding portion of the device to be mounted by being applied to channel 30) but does not expressly

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disclose that the said radio portion, and said data processing portion may be mounted in the attached housing with the antenna.

Baratono discloses an adhesive mounted on-board communication device including an antenna, a radio portion and a data processing portion for processing received data from the radio portion wherein the radio portion is mounted in the same housing with the antenna. (Col. 2 lines 50-55). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to include the radio and processing portions in the mounted device, as is suggested in Baratono (Col. 4 lines 24-32) that all communications circuitry, may be included in the same housing or certain portions may be placed elsewhere in the vehicle. Therefore it would have been reasonable to use the advantages of either situation, while the structure in Fisher would provide for more possibilities in antenna placement, it would also have been apparent to one of ordinary skill in the art that combining all circuitry in one device would provide for easier manufacturing.

Regarding claim 3, the combination of Fisher and Baratono discloses the Dedicated Short-Range Communications (DSRC) on-board unit with an adhesive material according to claim 1, wherein: said protruding portion is fitted into an aperture formed on said adhesive material. (See Fisher, Figure 4, wherein the adhesive layer, which includes the silicon and tape, form an aperture within which a protruding portion of the housing resides)

Regarding claim 4, the combination of Fisher and Baratono discloses the Dedicated Short-Range Communications (DSRC) on-board unit with an adhesive material according to claim 1, wherein: a height of said protruding portion is less than a thickness of said adhesive

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material. (See Fisher, Figure 4, wherein the adhesive layer, which includes the silicon and tape, form an aperture within which a protruding portion of the housing resides, and this protruding portion is narrower in thickness than the height of the silicon gel adhesive)

Regarding claim 5, the combination of Fisher and Baratono discloses the Dedicated Short-Range Communications (DSRC) on-board unit with an adhesive material according to claim 1, wherein: a leading end surface of said protruding portion is a flat surface. (See Figure 4 of Fisher, the portion of the protrusion adhered to the double sided tape is flat.)

Regarding claim 7, the combination of Fisher and Baratono discloses the Dedicated Short-Range Communications (DSRC) on-board unit with an adhesive material according to claim 1, wherein only a circumferential portion of the protruding portion is in engaged with the adhesive, (Figure 4).

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fisher (US 4,931,805) in view of Baratono (US 6,549,793) and further in view of Wunderlich (US 4,931,806).

Regarding claim 6, the combination of Fisher and Baratono discloses the Dedicated Short-Range Communications (DSRC) on-board unit with an adhesive material according to claim 1, but does not address how antenna adjustments are made. Wunderlich discloses a communication with an antenna in the adhesively mountable section wherein the antenna characteristics are matched by adjusting a shape of said antenna. (Col. 6 lines 5-17) Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to adjust the antenna characteristics by changing the shape, as the nature of antennas dictates that size and

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shape determine their characteristics, and by changing the shape to improve these characteristics may reduce loss and unwanted radiation at the device as well as improving the received signal. (See Wunderlich col. 5 lines 12-17) and Wunderlich further expresses that it incorporates the structure of the Fisher reference (see col. 3 lines 26-41)

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lewis G. West whose telephone number is 571-272-7859. The examiner can normally be reached on Monday-Friday 7:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew D. Anderson can be reached on 571-272-4177. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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